

10/29/02

**This Disposition Is not
Citable as Precedent of
the TTAB**

Paper No. 21
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re S.A. G.H. Martel et Cie

Serial No. 75/002,400

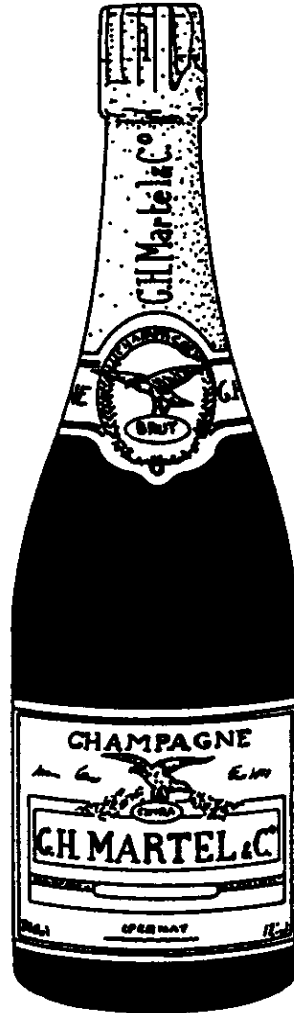
Luis Miguel Acosta of Plunkett & Cooney, P.C. for S.A. G.H. Martel et Cie.

Cynthia Sloan, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Seeherman, Quinn and Rogers, Administrative
Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

The goods identified in the application which is the subject of this appeal are "wines from France, namely Champagne." Applicant seeks to register, as a trademark for these goods, what we consider to be the labeling applied to its bottles of champagne. Lest all the detail in the mark be lost, we have included a large reproduction of the applied-for mark below.



The application does not include a description of the mark, but does include a statement that "the name shown in the mark does not identify a particular living individual," a statement that "the stippling in the drawing is for shading purposes only," and a statement that applicant "intends to use the mark by displaying it on the goods."

In addition, there is a disclaimer that reads "No claim is made to the exclusive right to use "CHAMPAGNE," "BRUT," "& CO." and "EPERNAY" [the geographic term at the bottom, middle of the main label] apart from the mark as shown."¹

In the initial Office action, the examining attorney required applicant to file an amended drawing and to "use broken or dotted lines to show the mark's position on the goods or container" and to "show the mark itself with solid lines." Though applicant filed an amended drawing, setting forth the mark as reproduced herein, applicant obviously did not use any broken or dotted lines. The examining attorney did not pursue the issue in subsequent Office actions. Nonetheless, we do not consider applicant to be seeking registration of the configuration of its champagne bottle, as adorned by the body and neck labeling. The bottle's shape is one commonly used for champagne and we do not consider applicant to be claiming the exclusive right to use champagne bottles in this shape. Rather, we consider applicant to be seeking registration of the body and neck labels and to have submitted the drawing it has

¹ The application was filed October 6, 1995 under Section 1(b) of the Lanham Act, i.e., the intent to use provision of the act, and included a claim to a priority filing date under Section 44(d) of the act, based on filing of a French application on June 13, 1995. Applicant has subsequently filed a copy of a French registration for its mark, has deleted the 1(b) basis, and now seeks registration under Section 44(e) of the act.

submitted solely to show the positioning of the labels. Thus, if applicant ultimately prevails in its appeal of the refusal of registration, applicant should file an amended drawing setting forth the elements of the champagne bottle other than its labeling in broken or dotted lining. See *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, n. 3 (TTAB 1996) and Trademark Rule 2.52(a)(2)(ii). We turn now to the issue on appeal.

Refusal of Registration Under Section 2(d)

The examining attorney refused registration of applicant's mark under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). The examining attorney reasons that there exists a likelihood of confusion or mistake or deception among consumers, in view of the prior registration of a wide variety of marks incorporating the term MARTELL, each registered, apparently by the same entity (see footnote 3, *infra*; hereafter registrant referred to as such or as Martell) for "cognac" or "cognac brandy" or "brandy."

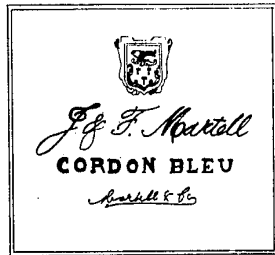
Though the cited registrations referenced in a list in the initial Office action did not precisely match the copies of registrations attached to the action², the

² There were copies of more registrations attached to the Office action than were referenced in the action.

examining attorney, in a subsequent Office action, corrected certain errors and clarified that the refusal of registration was based on 12 registrations. During the pendency of this appeal, two of the registrations were cancelled by the Office for registrant's failure to make necessary filings under Section 8 of the Lanham Act, 15 U.S.C. §1058. Accordingly, the refusal of registration is moot insofar as it is based on cited registrations 1,167,575 and 1,656,994. There are, however, ten other registrations cited in support of the refusal.

Of these ten registrations, nine are in the nature of label designs for bottles for registrant's cognac, cognac brandy or brandy. The tenth, no. 1,675,576, is for the typed slogan "COGNAC. THE ART OF MARTELL.". The nine label designs are set forth below.³

³ The nine surviving "MARTELL" labels are the subjects of registration nos. 555,941, 773,880, 1,261,887, 1,261,888, 1,321,155, 1,665,191, 1,665,193, 1,669,678, and 1,672,733. The Office's assignment records show title for the first six of these to be in Martell S.A. (Reel 1191, Frame 274). The last three of these registrations appear to be owned by Martell & Co., by virtue of the merger of Martell S.A. with Societe Flechoise de Participations and subsequent change of name to Martell & Co. (Reel 1191, Frame 274; Reel 2398, Frame 105; Reel 2398, Frame 80).





When the refusal of registration was made final, applicant appealed. Applicant concurrently filed both its appeal brief and a request for remand and further examination. Initially, there was some confusion about applicant's submissions - essentially, the brief and a request for reconsideration based on a purported consent from registrant to registration of applicant's mark -- and there was a delay in remanding the application to the examining attorney.⁴ After the examining attorney denied

⁴ The request for remand and reconsideration referenced a consent agreement, but none was attached thereto, and the Board initially

the request for reconsideration, the appeal was resumed. Applicant did not avail itself of the opportunity provided by the Board to file a supplemental appeal brief and, after the examining attorney filed a brief, applicant did not file a reply. There was no request for an oral hearing.

Analysis of Refusal and Record

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In the analysis of likelihood of confusion our focus is on the cumulative differences or similarities of the marks and goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

In articulating the basis for the refusal of registration, the examining attorney notes that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature

viewed the filing as a request to suspend the appeal so that applicant could seek a consent. Later, it was determined that certain letters attached to the appeal brief rather than the request for remand and reconsideration had, in fact, been submitted as evidence of registrant's consent. Accordingly, the suspension was vacated and the application was remanded to the examining attorney for consideration of the letters.

of a mark, so long as the ultimate conclusion on whether there exists a likelihood of confusion rests on consideration of the involved marks in their entireties. To explain why her analysis of the marks accords great weight to the MARTEL and MARTELL surnames that are visually prominent in the involved marks, the examining attorney argues that when a mark consists of words and design elements, the words tend to dominate; that many of the words other than the MARTELL surname or the "J & F Martell" signature on registrant's labels have been disclaimed and therefore may be regarded as less significant; that the MARTELL name would be used to call for registrant's goods; and, for these reasons, the MARTELL name or signature is the dominant element of the marks in the cited registrations. For similar reasons, i.e., the dominance of words over designs, the disclaimer of much other wording, and the anticipation that the prominently displayed surname will be used to call for the goods, the examining attorney finds MARTEL to be the dominant element in applicant's mark. MARTELL and MARTEL, the examining attorney notes, are identical in sound, and nearly identical in appearance, and both are surnames. Further, the examining attorney argues, applicant's use of the initials G.H. and

registrant's use of the initials J&F do not overcome the nearly identical nature of the surnames.

The examining attorney acknowledges that the composite label designs have visual differences but argues that the differences are not significant enough to be recalled by consumers whose recall is fallible and who may not be able to make a side-by-side comparison. In addition, the examining attorney argues that four of registrant's nine label designs and applicant's label all feature a particular design element, specifically, a bird in flight.

As to the goods, the examining attorney has made of record numerous registrations wherein a single mark has been registered for champagne and brandy or cognac, or champagne and both brandy and cognac. In addition, the examining attorney argues that, even if champagnes, on the one hand, and brandies or cognacs, on the other hand, may be sold in different sections of stores they will nonetheless be sold in similar outlets to the same general class of consumers.

Applicant, applying the Second Circuit's *Polaroid* factors⁵, argues that the examining attorney has made

⁵ *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 128 USPQ 411, cert. denied, 368 U.S. 820, 131 USPQ 499 (1961). As already noted, our applicable precedent is not the *Polaroid* decision but the *du Pont* decision. Nonetheless, applicant has

certain critical errors. First, applicant argues that the examining attorney, in assessing the similarity of the involved marks, has inappropriately focused on a comparison of the surnames in the marks, and has neglected to give proper consideration to the "highly stylized fonts and label design elements" of the marks, as well as to applicant's "bottle configuration." Applicant argues that a comparison of its mark with each of registrant's label designs reveals that applicant's mark is unlike any of the registrant's various labels, because of dissimilar designs and dissimilar wording. Second, applicant argues that registrant's marks are weak and entitled to limited protection, in that MARTEL [sic] appears in "over one hundred filings" gathered from "U.S. Patent and Trademark Office records, the state registries and a database identifying brands and their companies." Third, applicant argues that the involved products are "distinctly different," and easily distinguishable by consumers. Specifically, applicant notes that champagne and cognac are geographic indications of origin, that they signify alcoholic beverages with not only different geographic origins but also with different concentrations of alcohol,

focused on *Polaroid* factors which are largely equivalent to *du Pont* factors that are applicable to this case.

and that the beverages designated by these terms are used for different purposes and "imbibed in quite different fashions"; cognac is used as a before or after meal aperitif or, chiefly in France, as an "eye-opener" with coffee, and is served in a snifter, while champagne is used for celebratory toasting and is served in a flute.

In regard to the marks, we agree with the examining attorney that MARTEL and MARTELL are the dominant elements of, respectively, applicant's and registrant's marks. See *E. Remy Martin & Co. v. Shaw-Ross International Imports, Inc.*, 756 F.2d 1525, 225 USPQ 1131, 1135 (11th Cir. 1985) (Court found displays of REMY and F.REMY on, respectively, cognac and champagne or sparkling wine, would not prompt consumers to examine carefully the differences of the displays; and court found that much cognac brandy is consumed by glass at bars or restaurants and is ordered by name). As with the displays in *Remy Martin*, we do not find the flourishes, borders and other design elements on applicant's and registrant's labels so distinctive that they would be utilized by consumers to distinguish one source from another. Consumers are more likely to rely on the prominent surnames displayed on the respective labels. For reasons articulated by the examining attorney, we agree that the marks are similar.

Applicant's argument that registrant's marks are weak and entitled to limited protection is supported only by a search report from a private company's database, not by copies of the registrations. While this is not the proper method for introducing third-party registrations into the record, the examining attorney did not object to submission of the search report at a point when applicant could have submitted proper copies of the registrations; in fact, the examining attorney addressed the contents of the report. Therefore we have considered the report for whatever probative value it may have.⁶ In essence, applicant argues that, because the letter string MARTEL appears in numerous federally-registered or state-registered marks, such as "SMARTEL," "SMARTEL P.O.S.ITIVE," "MD MARTEL-DERNIER," "T.J. MARTELL ROCKER SOCCER," "MARTELLI," "MARTEL," "FIRINO-MARTEL," "MG THE MARTEL GROUP," "MARTELLO," and "MARTELL," among others, that marks including the letter string are weak. We do not agree with the premise of the argument, i.e., that mere appearance of a particular letter string in numerous marks renders the marks including that string weak. Moreover, the registrations applicant relies

⁶ Listings of state registrations do not have the probative value of federal registrations in showing the weakness or significance of a mark, nor do listings of what are purported to be common law uses, but which do not show the actual use.

on are for a wide variety of goods and services, and none includes either champagne or brandy, or even wine or spirits, for that matter.

Next, we consider the goods. While applicant discusses numerous reported decisions involving trademarks in advancing its argument that there is no likelihood of confusion, it places particular reliance on three decisions. In two of these decisions, courts found no likelihood of confusion, or no infringement, when apparently similar marks were used, respectively, in connection with wines and brandies. These are *Buitoni Foods Corporation v. Gio. Buton & C. S.p.A.*, 680 F.2d 290, 216 USPQ 558 (2d Cir. 1982) (BUITONI registered by junior user for Italian-style foods and wines and senior user, a producer of brandies, liqueurs and aperitif wines, had applied to register BUTON; appeals court affirmed district court's reversal of Trademark Trial and Appeal Board decision ordering cancellation of the BUITONI registration, agreeing with district court that confusion was not likely), and *Peyrat, dba Societe Saint-Louvent Peyrat & Cie v. L.N. Renault & Sons, Inc.*, 247 F.Supp. 1009, 148 USPQ 77 (SDNY 1965) (Court granted declaratory judgment action in favor of plaintiff, holding that there was no likelihood of confusion created by concurrent use of RENAULT and RENAULT

& CO. for cognac brandy and RENAULT for wines and champagnes). In the third decision, *In re National Distillers & Chemical Corp.*, 297 F.2d 941, 132 USPQ 271 (CCPA 1962) the predecessor of our reviewing court found no likelihood of confusion between MERITO for rum and MARQUES DEL MERITO for wines.

We agree with the examining attorney that the *Buitoni* case is distinguishable, because the district court found the BUITONI and BUTON marks phonetically different, unlike the case at hand, wherein MARTEL and MARTELL are phonetically identical. In addition, the court found that use of the BUTON mark for brandy was less prominent than the principal mark of VECCHIA ROMAGNA. In the case at hand, MARTEL is the dominant element of applicant's mark.

We also do not find the *Peyrat* case to be persuasive authority. The involved parties had previously settled opposition proceedings brought by plaintiff against defendant, and the district court's decision is very much an equitable decision. Specifically, the court held, for various equitable reasons, that the plaintiff "should be permitted" to use the RENAULT and RENAULT & CO. marks with cognac brandy; but the parties were ordered to prepare a final decree for the court that included "appropriate provisions" to safeguard against confusion. Moreover, the

Peyrat decision is based, in part, on a principle of law that is no longer viable. Specifically, the court found precedent in the Second Circuit for the proposition that wine and distilled alcoholic beverages "may be properly considered in separate categories" for trademark purposes; and the court also relied on the U.S. Patent and Trademark Office's separate categories for such beverages. We note, in this regard, that classification of goods is not determinative of the question of likelihood of confusion. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993). Goods need not be identical or competitive for a likelihood of confusion to be found. Rather, it is sufficient that they are related in some manner or that the circumstances of marketing of the goods are such that the goods are likely to be encountered by persons who would assume some relation or that they emanate from the same source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). See also, *Remy Martin*, supra, 225 USPQ at 1134, in regard to applicant's argument that consumers will not mistakenly purchase champagne when seeking cognac, or vice versa ("The question, however, is not whether the purchasing public can readily distinguish wine from cognac but whether the

products are the kind the public attributes to a single source.").

In regard to whether applicant's champagne and registrant's brandy, cognac and cognac brandy are the kind of products the public attributes to a common source or sponsor, we note the nine third-party registrations the examining attorney has made of record, each of which is for a single mark registered for champagne and brandy or cognac, or champagne and both brandy and cognac. It is well settled that such registrations have probative value insofar as they suggest that the goods are of a type that may emanate from a single source under a single mark. *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999), *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993), and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

In addition, the record reveals that "[i]n France, Champagne indicates a region of chalky soil," that the geographic region of France known as Champagne has such soil, and that "[t]he chalky subsoil of the Charente region⁷ is very similar to that in the district of Champagne much farther north, thus the classification of the best Cognacs

⁷ Cognac is a town within the Charente region but has, over time, supplanted Charente as the more familiar name for the region.

as 'champagnes.'" (Exhibits G and H, applicant's January 6, 1997 response to the examining attorney's Office action). The record also reveals that "Chalk-lime [soil] is a mother-bed for exceptional vines." *Id.* In short, it appears that the fine, sparkling wines of the Champagne region and the best brandies of the Cognac region are the products of grapes with very similar characteristics. In *Remy Martin, supra*, 225 USPQ at 1134-35, after observing that cognac and brandy are distilled from wine, the court concluded that even "a sophisticated consumer from the drinking world ... could easily conclude" that a cognac and brandy maker had undertaken the production of wine and therefore held that "[c]ontrary to the lower court's finding, there is thus a high degree of similarity between the goods." Similarly, in this case, we find that even a sophisticated consumer from the drinking world, knowing that cognac and champagne can be manufactured based on grapes with the same attributes, could easily overlook the slight visual difference between MARTEL and MARTELL and conclude that there was a relationship between the products or producers of MARTEL champagne and MARTELL cognac.

In *In re Leslie Hennessy, Jr.*, 226 USPQ 274, 276 (TTAB 1985), the Board held: "While we recognize that cognac brandy is specifically different from wine and that brandy

and wine would likely be sold at different sections of retail liquor stores, the fact remains that wine and cognac brandy are alcoholic beverages which flow through the same channels of trade to the same classes of purchasers."

In short, we find the goods related for the purpose of analyzing whether there exists a likelihood of confusion among consumers. Having found that, for likelihood of confusion purposes, the marks are similar and the goods are related, we could conclude that there is a likelihood of confusion in this case. However, one further, often significant, *du Pont* factor requires consideration. Specifically, this is the market interface between applicant and registrant.

Registrant's Letter of Consent

One type of market interface contemplated by the *du Pont* decision, and frequently a significant factor in decisions issued by our reviewing court, is whether the applicant and registrant have entered into a consent agreement. The third of the cases on which applicant chiefly relies to support its argument for registration, *National Distillers*, involved such an agreement. By virtue of the agreement, the owner of a registration for MARQUES DEL MERITO for wines had consented to applicant's use and

registration of MERITO for rum. The registration had been cited by the examining attorney as a bar to registration of the applicant's mark, and this Board affirmed. On appeal, the consent agreement was a significant factor leading to reversal of the Board's decision.

We distinguish the instant case from *National Distillers*. The record does not show that we have the same type of agreement to use and registration in this case.

The items in the record which bear on the question whether registrant has consented to applicant's use and/or registration of the involved label designs are a declaration from applicant's chairman, submitted with applicant's January 6, 1997 response to an Office action, and the two letters submitted with applicant's request for reconsideration of the final refusal. One of the letters is from applicant's French counsel to its United States counsel. The other letter, in French but translated by applicant's U.S. counsel, is from the General Secretary of the firm G.H. Mumm & Cie. to Mr. Jean-Francois Rapeneau of Champagne Rapeneau.

The declaration of applicant's chairman, Christophe Rapeneau, is dated February 3, 1995.⁸ It attests to

⁸ The declaration is dated prior to the filing of both the involved application and the French application on which the

continuous use by applicant of its MARTEL mark in France since 1869; continuous use of the MARTEL mark in commerce between France and the United States since the "beginning of this century"; that "Applicant's 'MARTEL' and Registrant's 'MARTELL' coexist on the trademark registers of ... France, Algeria, Austria, Benelux, Germany, Italy, Liechtenstein [sic], Monaco, Portugal, Spain and Switzerland"; that such registrations "have coexisted without incident"; that the "parties' respective marks coexist in ... Australia, Great Britain, Greece, Japan, Mexico and the United States"; that there "are no known instances of confusion between 'MARTEL' and 'MARTELL' in any of the countries [in which there are coexisting registrations or uses]"; and that "Applicant has begun concurrent use/coexistence negotiations with the French parent company of Martell."⁹ There is no indication in the record that a concurrent use/coexistence agreement ever

involved application is based. Further, the declaration's caption reveals that it was prepared as a filing for application serial no. 74/293,358. The mark in that application, a version of the main body label shown in the mark involved herein, has also been refused registration by the examining attorney, but the appeal is in suspension. Though the declaration was prepared for filing in the other application it appears applicant considers it equally relevant to the application now before us.

⁹ The declaration also attests to use in commerce of certain specimens submitted for application serial no. 74/293,358, but that is irrelevant to this appeal. While the declaration does

resulted from the negotiations; at least, applicant has not supplied any such document, the only "agreement" which has been submitted being a letter from G.H. Mumm dated March 30, 1989, and discussed below.

Turning to the two letters submitted with applicant's request for reconsideration, the first is a February 25, 1998 letter from French counsel for applicant to U.S. counsel for applicant and references "proof of an agreement, a copy of which is enclosed, signed by COGNAC MARTELL's head office, the firm MUMM." French counsel also wrote that the "agreement has always been respected since the date of its signature"; that the letter evidences "agreement to the Trademark MARTEL" of applicant by "COGNAC MARTELL, through its head office"; that applicant and COGNAC MARTELL "have been coexisting in France since about one hundred years and in many European countries"; that their "coexistence was formalized through a group agreement" and "[s]uch an agreement is sufficient in the eyes of the French law and ought to be extended to the other concerned countries."

The second letter attached to, and referenced in, the first letter, i.e., "the proof of an agreement" is a March

not so specify, we presume applicant's use and registration of its MARTEL mark covers champagne.

30, 1989 letter from G.H. Mumm & Cie to Champagne Rapeneau. Applicant's counsel explains that G.H. Mumm & Cie is "the parent entity to Cognac Martell, the related parent entity of J&F Martell, Inc., the New York corporation owning the registrations upon which the examining attorney bases her rejection." Counsel has not explained the relationship between applicant and the firm to which the letter from Mumm is addressed, i.e., Champagne Rapeneau.

We agree with the examining attorney that the letter from Mumm to Champagne Rapeneau is not probative evidence of registrant's consent to applicant's registration of the involved mark. The letter refers to the agreement of G.H. MUMM and the MARTELL organization to a packaging scheme for applicant's champagne. Even if we assume that the reference to packaging is a reference to the bottle and labels thereon, as opposed to a carton or other container for a bottle of champagne, we do not know to what version of applicant's label the letter refers. The record does not reveal the particular label or packaging discussed by the parties in 1989, i.e., many years prior to the filing of both the involved application and the French application which provided the priority filing basis for the involved application, or whether such packaging was, in fact, the same as that illustrated by the mark in the involved

application. Specifically, we have no way of knowing what elements of the packaging were crucial to Mumm's decision to agree to use by Champagne Rapeneau of the packaging. In addition, we do not know the relationship between Champagne Rapeneau and applicant and whether the agreement of the Mumm and Martell organizations with Champagne Rapeneau inures to the benefit of applicant. Also, the letter from applicant's French counsel to its U.S. counsel appears to allude to some other agreement, specifically that "coexistence [of applicant and registrant] was formalized through a group agreement." Even if we take this reference to mean that there is a more formal agreement than the letter signed only by G.H. Mumm, it is not of record and cannot bear on our decision.

In regard to the letter from French counsel to U.S. counsel, we find no probative value in French counsel's assertion that if French law finds the "formalized ... group agreement" sufficient to allow applicant and registrant to coexist in France and European countries, then it ought to be sufficient for other countries. This is so not just because the record does not include a copy of any group agreement which may exist, but because we must be concerned with agreements dealing with business and goodwill relative to marks in the United States and "are not bound to

recognize or rely upon foreign law and disagreements abroad settle[d] under it." See *Remy Martin, supra*, 225 USPQ at 1135, citing *Roger & Gallet v. Janmarie, Inc.*, 245 F.2d 505, 510, 114 USPQ 238, 241-42 (CCPA 1957).

Finally, we do not find the declaration of applicant's chairman sufficient to remedy the deficiencies we see in applicant's proffered evidence of the existence of an agreement by registrant to registration of applicant's mark. The self-serving statements in the declaration would have much greater probative value were they from registrant's chairman, rather than from applicant's chairman.

In short, we cannot conclude that registrant consented to applicant's registration of the mark in the instant application. Thus, this factor does not weigh in applicant's favor.

Decision: The refusal of registration under Section 2(d) of the Lanham Act is affirmed.¹⁰

¹⁰ In reaching our conclusion, we do not minimize the probative value to be accorded proper evidence of a registrant's consent to registration of a particular mark in a particular application. We simply do not find the record sufficient in this regard.